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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,277	10/05/2006	5830237		2496

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STANDLEY LAW GROUP LLP  
495 METRO PLACE SOUTH  
SUITE 210  
DUBLIN, OH 43017

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Dr. Aldo A. Laghi  
c/o Ronald A. Christaldi  
P.O. Box 2350  
Tampa, FL 33601-2350

***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/008,277

PATENT NO. 5830237

ART UNIT 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	Control No. 90/008,277	Patent Under Reexamination 5830237	
	Examiner David O. Reip	Art Unit 3993	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 05 October 2006 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: \_\_\_\_\_

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a) ☐ by Treasury check or,  
b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or  
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester ( if third party requester )

### **DECISION ON REQUEST FOR REEXAMINATION**

A substantial new question of patentability affecting claims 1, 2, 4, 6-8, 12-16 and 18-23 of United States Patent Number 5,830,237 to Kania (herein after "the '237 patent") is raised by the request for *ex parte* reexamination.

### ***Service of Papers***

After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

### ***Waiver of Right to File Patent Owner Statement***

In a reexamination proceeding, Patent Owner may waive the right under 37 CFR 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 CFR 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 CFR 1.248. If the request for reexamination was made by a third party requester, see 37 CFR 1.550(f). The Patent owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

*Patent Owner waives the right under 37 CFR 1.530 to file a Patent Owner Statement.*

### ***Extensions of Time***

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

### ***Amendment in Reexamination Proceedings***

Patent Owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

### ***Notification of Concurrent Proceedings***

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the '237 patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

The references relied upon in the request are as follows:

1. *O&P Business News* dated September 1, 1994 (Advertisement of Silipos, p. 9)(hereinafter, the "Sep 1994 O&P Publication")
2. *O&P Business News* dated October 1, 1994 (Advertisement of Silipos)(hereinafter, the "Oct 1994 O & P Publication")
3. *O&P Business News* dated January 1, 1995 (Advertisement of Silipos, p. 16 and p. 22, and Advertisement of Cascade Orthopedic Supply, Inc. of Iceross <sup>TM</sup>, p. 23)(hereinafter, the "Jan 1995 O&P Publication")
4. 1994 Catalog of Silipos Advanced Polymer Technology (hereinafter, the "1994 Silipos Catalog")
5. Handbook of Thermoplastic Elastomers, Chapter 3, 1979 (hereinafter, the "1979 Handbook")
6. Shell Chemical Technical Bulletin SC:1102-89 "Kraton® Thermoplastic Rubber in Oil gels," dated April 1989 (hereinafter, the "1989 Shell Publication")
7. U.S. Pat. No. 3,983,870 to Herbert et al (hereinafter, "Herbert")
8. U.S. Pat. No. 5,633,268 to Chen (hereinafter, "Chen")

The request indicates that the requester considers:

(1) Independent claim 1 and dependent claims 4, 13-16 and 20-22 are unpatentable over the Jan 1995 O&P Publication taken with the Sep 1994 O&P Publication, Chen, and Herbert.

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(2) Dependent claims 6-8, 12, 18 and 19 are unpatentable over the Jan 1995 O&P Publication taken with the Sep 1994 O&P Publication, Chen, Herbert, the 1979 Handbook, the 1994 Silipos Catalog, and the 1989 Shell Publication.

(3) Dependent claims 2 and 23 are unpatentable over the Jan 1995 O&P Publication taken with the Sep 1994 O&P Publication, Chen, Herbert, and the Oct 1994 O&P Publication.

### ***The O&P Publications***

The O&P Publications are new teachings, not previously considered nor addressed in the prior examination of the patent or a final holding of invalidity by the Federal Courts.

The O&P Publications raise an SNQ with respect to claims 1, 2, 4, 6-8, 12-16, and 18-23.

Independent claim 1 requires, *inter alia*, "A tube sock-shaped covering for enclosing an amputation stump, said covering having an open end for introduction of said stump and a closed end opposite said open end, said covering comprising fabric in the shape of a tube sock coated on only one side thereof with a...gel composition." The Jan 1995 O&P Publication teaches a tube sock-shaped "Single Socket Gel Liner" comprising a fabric with a gel liner, and the Sep 1994 O&P Publication teaches the same tube sock-shaped "Socket Gel Liner" covering comprising a fabric coated on only one side (i.e. the inside) with a polymeric gel (seen in the circular figure, which shows

fabric, a layer of polymer gel, and then skin). During the prosecution of the application that became the '237 patent, at least one publication disclosing the Silosheath was made of record. However, the publication did not clearly teach the fabric of the sheath being coated on only one side thereof with the polymer gel. Thus, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claim 1 was patentable. Accordingly, the O&P Publications raise an SNQ as to independent claim 1 and claims that depend therefrom, which has not been decided in a previous examination of the '237 patent.

***Additional teachings of Chen, Herbert, the 1979 Handbook, the Silipos Catalog, and the 1989 Shell Publication***

Chen, Herbert, the 1979 Handbook, the Silipos Catalog, and the 1989 Shell Publication are new teachings, not previously considered nor addressed in the prior examination of the patent or a final holding of invalidity by the Federal Courts.

The above listed teaching references, when taken with the O&P Publications, raise an SNQ with respect to claims 1, 2, 4, 6-8, 12-16, and 18-23.

Independent claim 1 requires, *inter alia*, "a block copolymer with mineral oil." Chen teaches the use of block copolymers, with mineral oil as plasticizers (col.6, lines 11-25), in combination with various substrates such as fabric, for articles such as braces for the hand, knee, leg, etc.



Dependent claim 4 requires, *inter alia*, "tube sock-shaped covering...wherein the gel has a uniform thickness profile." Herbert teaches a spraying process for achieving uniform thickness in applying a polymer to a textile (col. 4, lines 38-68).

Dependent claim 6 requires, *inter alia*, "wherein said block copolymer is a styrene isoprene/butadiene block copolymer." The 1979 Handbook teaches forming polymers using styrene, isoprene/butadiene.

Dependent claim 8 requires, *inter alia*, "wherein said gel composition comprises 60-85% by weight mineral oil. Both the Silipos Catalog and the 1989 Shell Publication teach the use of mineral oil as a plasticizer in forming block copolymers.

Therefore, taken together with the teachings of a tube sock-shaped fabric stump sheath with a gel liner of the O&P Publications, there is a substantial likelihood that a reasonable examiner would consider the additional teachings of Chen, Herbert, the 1979 Handbook, the Silipos Catalog, and the 1989 Shell Publication important in deciding whether or not these claims are patentable. Accordingly, the above discussed references, when taken together with the teachings of the O&P Publications, raises an SNQ as to claims 1, 2, 4, 6-8, 12-16, and 18-23, which has not been decided in a previous examination of the '237 patent.

### ***Conclusion***

For the reasons given above, each of the references cited by the requester raises a substantial new question of patentability with respect to the subject patent. Since requester did not request reexamination of claims 3, 5, 8-11 and 17 and did not

assert the existence of a substantial new question of patentability (SNQ) for such claims (see 35 U.S.C. § 311(b)(2); see also 37 CFR 1.915b and 1.923), such claims will not be reexamined. This matter was squarely addressed in *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. The District Court upheld the Office's discretion to not reexamine claims in an *inter partes* reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

"To be sure, a party may seek, and the PTO may grant, ... review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which ... review was not requested, nothing in the statute compels it to do so. To ensure that the PTO considers a claim for ... review, § 311(b)(2) requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that Sony did not seek review of every claim under the '213 and '333 patents. Accordingly, Sony cannot now claim that the PTO wrongly failed to reexamine claims for which Sony never requested review, and its argument that AIPA compels a contrary result is unpersuasive."

Accordingly, only claims 1, 2, 4, 6-8, 12-16 and 18-23 of the subject patent will be reexamined.

**All** correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

By **U.S. Postal Service Mail** to:

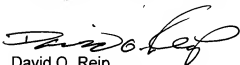
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By FAX to: (571) 273-9900  
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By hand to: Customer Service Window  
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Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.



David O. Reip  
Primary Examiner  
Central Reexamination Unit  
(571) 272-4702

Conferee 

Conferee 